

## **REMARKS/ARGUMENTS**

The rejections presented in the Office Action dated July 25, 2008, (hereinafter Office Action) have been considered, and reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses each of the prior art rejections (§§ 102(b) and 103(a)), each of which is based upon the teachings of U.S. Publication No. 2002/0191017 by Sinclair *et al.* (hereinafter “Sinclair”), because Sinclair has not been shown to teach or suggest each of the claimed limitations. For example, Sinclair has not been shown to teach receiving captured speech of another user through a radio connection and reproducing the captured speech of the other user, as claimed in independent Claims 1, 15, 29, and 44. While the cited portions of Sinclair teach that a user may input voice commands to an IVRU system and receive voice data from the IVRU system, the received data relates to a virtual voice character in the game (paragraphs [0087]-[0088]) and not another user of the game. No teaching or suggestion has been identified in Sinclair that a user receives captured speech of another user of the game. Without a presentation of correspondence to each of the claimed limitations, the prior art rejections are improper.

In order to anticipate a claim, the asserted reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.* every element of the claimed invention must be literally present, arranged as in the claim. *Net MoneyIn Inc. v. Verisign*, (Fed. Cir. 2008); *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain the rejection based on 35 U.S.C. § 102. Applicant respectfully submits that Sinclair has not been shown to teach every element of at least independent Claims 1, 15, 29, and 44, in the requisite detail and therefore fails to anticipate Claims 1, 2, 15, 16, 29, and 44. Applicant accordingly requests that the rejection be withdrawn.

Dependent Claims 2 and 16 depend from independent Claims 1 and 15, respectively, and also stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Sinclair.

While Applicant does not acquiesce to the particular rejection to these dependent claims, the rejection is also improper for the reasons discussed above in connection with the independent claims. These dependent claims include all of the limitations of their respective independent claims and any intervening claims, and recite additional features which further distinguish them from the cited reference. Therefore, the rejection of dependent Claims 2 and 16 is improper, and each of these dependent claims is also patentable over the teachings of Sinclair. Applicant accordingly requests that the § 102(b) rejection be withdrawn.

With respect to the § 103(a) rejection of dependent Claims 3-14, 17-18, and 32-43 based upon a modification of the teachings of Sinclair with those of U.S. Publication No. 2006/0165027 by Heden (hereinafter “Heden”), Applicant respectfully traverses. As discussed above, Sinclair fails to correspond to each of the limitations of independent Claims 1, 15, 29, and 44 and the further reliance on Heden does not overcome the above-discussed deficiencies in Sinclair. In addition, Heden merely teaches that a mobile station’s capabilities be taken into account when negotiating quality of service for a service, not that a mobile station transfers both speech and game data using any of the identified connections, as claimed. The mere assertion that one of ordinary skill would have modified Sinclair to negotiate a quality of service as taught by Heden fails to provide correspondence to several of the limitations absent from the teachings of Sinclair. For example, modifying Sinclair to negotiate a quality of service does not provide for transferring speech and game data in Sinclair’s system using specific transfer protocols, but rather, it would merely involve taking into account a device’s capability to use such protocols when making a connection. Without correspondence to each of the claimed limitations, the § 103(a) rejection is also improper, and Applicant requests that the rejection be withdrawn.

Moreover, the assertion that a skilled artisan would look to the teachings of Heden to modify the system of Sinclair fails to articulate the requisite evidence to support the rejection and is based upon hindsight reasoning. First, the mere assertion that one would modify the teachings of Sinclair fails to provide any rationale or evidence for making the asserted modification. Second, Heden makes no mention of, and is unrelated to, transferring speech and game data. A skilled artisan using common sense would not look to Heden’s negotiation of quality of service to modify Sinclair’s game service. “Combining prior art references without

evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). “Not only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution.” *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). Therefore, Applicant respectfully submits that the proffered motivation is a hindsight modification of prior art based on Applicant’s teachings, and the requisite showing of motivation to modify Sinclair with the teachings of Heden has not been met. Applicant accordingly requests that the § 103(a) rejection be withdrawn.

In an effort to facilitate prosecution and without acquiescing to characterizations of the asserted art, Applicant’s claimed subject matter, or to the applications of the asserted art or combinations thereof to Applicant’s claimed subject matter, Applicant has amended independent Claim 30 to characterize that the radio connection is a Dual Transfer Mode connection as was claimed in original Claim 34. Thus, the changes do not introduce new matter. Since the asserted modification of Sinclair fails to teach the claimed use of a Dual Transfer Mode connection as discussed above, the asserted combination of teachings fails to teach or suggest the limitations of amended Claim 30. Therefore, each of Claims 30 and 35-43 are also believed to be patentable over the asserted teachings.

It should also be noted that Applicant does not acquiesce to the Examiner’s statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant’s invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner’s characterizations, conclusions, and rejections in future prosecution.

Claims 15 and 29 have also been amended to alter the wording of the claims. For example, the preambles have been shortened. These changes are not made for any reasons related to patentability or to the asserted references and do not introduce new matter. These claims, with or without the changes, are believed to be patentable over the teachings of the asserted references for the reasons set forth above.

Further, Claims 31-34 have been canceled without prejudice, and Applicant reserves the opportunity to pursue the subject matter of these claims in the future. However, the cancellation of these claims renders any rejections of these claims moot, and Applicant accordingly requests that the rejections of these claims be withdrawn.

Authorization is given to charge Deposit Account No. 50-3581 (NKO.031.A1) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the Examiner is invited to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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